

Serial No.: 10/713,773  
Amendment dated 01 November 2005  
Reply to Office Action mailed 01 September 2005

### REMARKS

This Patent Application has been reconsidered carefully in light of the final Office Action dated as mailed on 01 September 2005. A careful reconsideration of the application by the Examiner in light of the foregoing amendments and the following remarks is respectfully requested.

There is no additional claim fee due for this Amendment because the total number of claims does not exceed the number of independent and dependent claims for which fees have previously been paid.

### Amendments to the Claims

Applicants have amended Claims 1 and 10 to place the limitations of the previously dependent Claim 8 within the independent Claims 1 and 10. Claim 8 has been canceled accordingly. Applicants have also amended Claims 1 and 10 to place the order limitations of previous Claim 18 within the independent Claims 1 and 10.

Applicants have amended Claim 20 to place the limitations of the previously dependent Claim 21 within the independent Claim 20. Claim 21 has been canceled.

Independent Claim 20 was further amended to include the limitation that the first portion of the back sheet is generally coextensive with the label portion. This

CD-134

12

KDE/as

Serial No.: 10/713,773  
Amendment dated 01 November 2005  
Reply to Office Action mailed 01 September 2005

amendment is fully supported by the specification at page 17, lines 12-15. Independent Claim 20 was also amended to better define the steps of Applicants' claimed method. These amendments are fully supported throughout Applicants' specification, for example, at page 20, lines 11-19, and page 22, line 13 to page 23, line 3.

Claims 1-7, 9-16, 19, 20, 22, 23, and 25 remain in the application.

#### **Limitations of Previous Claim 18**

As referred above, Applicants have inserted the full limitations of previous Claim 18 into Claims 1 and 10. Applicants urge that such amended claims, now including the order limitation of previous Claim 18, should result in allowance of Claims 1-7, 9-16, 19, 20, 22, 23, and 25.

#### **Claims Rejections - 35 U.S.C. § 102**

Claims 1-7, 10-12, 16, 19, 20, 22 and 23 were rejected under 35 U.S.C. § 102(d) as being anticipated by U.S. Patent 6,543,508 to Koch (hereinafter "Koch"). This rejection is respectfully traversed, particularly in view of the above Amendment and the following remarks.

Independent Claims 1 and 10 were amended to require that the carrier portion of the label assembly remains on the apparatus following application of the label portion onto the object. This amendment is fully supported by Applicants'

CD-134

13

KDE/as

BEST AVAILABLE COPY

Serial No.: 10/713,773

Amendment dated 01 November 2005

Reply to Office Action mailed 01 September 2005

previous Claim 8, which has now been canceled. Independent Claim 20 was amended to include the step of removing the label assembly from the indexed position to transfer the label portion from the label assembly onto the object surface. This amendment is fully supported by Applicants' previous Claim 21, which has now been canceled.

Koch discloses a compact disk labeling system used to adhere a label on a compact disc in the following manner. First, a label, having its adhesive side exposed and facing upwards, is placed on a flat shelf within the labeling system. Second, a compact disc is placed within the labeling system such that the disc contacts the flat shelf and, thus, comes in contact with the adhesive side of the label. When the disc is pressed against the label, the label attaches to the disc. Finally, the disc is removed from the labeling system together with the label, which is adhered to the disc.

Koch does not teach or suggest a method for transferring a label portion from a label assembly onto an object, wherein the carrier portion of the label assembly remains on the apparatus following transfer of the label portion onto the object. Koch also does not teach or suggest a method for transferring a label portion from a label assembly onto an object comprising the step of removing the label assembly from the

Serial No.: 10/713,773  
Amendment dated 01 November 2005  
Reply to Office Action mailed 01 September 2005

indexed position to transfer the label portion from the label assembly onto the object surface.

Thus, Koch does not disclose each and every element or limitation of independent Claims 1, 10 and/or 20, as required for a reference to anticipate a claim under 35 U.S.C. § 102. Consequently, Applicants respectfully request withdrawal of this rejection.

Claims 20-23 and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by PCT International Application WO 01/28866 to Ronngard (hereinafter "Ronngard"). This rejection is respectfully traversed, particularly in view of the above Amendment and the following remarks.

As discussed above, independent Claim 20 was amended to include the limitation that the first portion of the back sheet is generally coextensive with the label portion.

Ronngard discloses a two-step method for applying a label to a compact disc. First, only a small, strip-shaped portion of the covering sheet 26, extending diametrically over the label, is removed exposing the adhesive layer underneath it, and the strip-shaped portion of the label is fastened to the compact disc. Second, the remaining portions of the covering sheet positioned at opposite sides of the strip-

Serial No.: 10/713,773  
Amendment dated 01 November 2005  
Reply to Office Action mailed 01 September 2005

shaped adhesive layer are removed from the label, and the remaining portions of the label are adhered to the compact disc.

Ronngard does not teach or suggest a method for transferring a label portion from a label assembly onto an object comprising the step of removing a first portion of a back sheet from a face sheet of the label assembly to expose an adhesive side of the label portion, wherein the first portion of the back sheet is generally coextensive with the label portion.

Moreover, Ronngard discloses a labeling system, wherein "the label is applied against the compact disc while being guided by means of the edge surface 40 against the peg 4" (Ronngard, page 4, lines 27-30). Moreover, as shown in Fig. 4, the generally square periphery of the label assembly, as suggested by Ronngard, extends well beyond the bounds of the limiting surface 8. Therefore, contrary to Examiner's contention, Ronngard does not teach or suggest an indexing element formed on a periphery of the label assembly interfering with a guide formed on the apparatus base surface, as required by Applicants' invention as claimed in independent Claim 20.

Thus, Ronngard does not disclose each and every element or limitation of independent Claim 20, as required for a reference to anticipate a claim under 35 U.S.C. § 102. Consequently, Applicants respectfully request withdrawal of this rejection.

CD-134

16

KDE/as

Serial No.: 10/713,773

Amendment dated 01 November 2005

Reply to Office Action mailed 01 September 2005

### Claims Rejections - 35 U.S.C. § 103

Claims 1-4, 6-14, 16, 17 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,748,994 to Wien et al. (hereinafter "Wien") in view of U.S. Patent 6,612,355 to Cook et al. (hereinafter "Cook"). This rejection is respectfully traversed, particularly in view of the above Amendment and the following remarks:

Wien discloses a labeling method wherein a label is peeled off of its supporting sheet using no-touch tabs and placed on an applicator with the adhesive side thereof facing upwards. An article, such as a disc, is then placed on the applicator and pressed downwards to connect with the label. After the label has adhered to the disc, the labeled disc is lifted from the labeling assembly, and the tabs of the label are torn off from the affixed label.

Cook discloses a labeling system wherein a label is trapped between retention elements 44 and platen 12 prior to application to a disc. When the disc is slid down the hub 14 to contact the label 16, retention elements 44 release the label, and the label attaches to the disc. The labeled disc is then raised away from the labeling apparatus.

Neither Wien nor Cook, individually or in combination, teaches or suggests a method for transferring a label portion from a label assembly onto an object

CD-134

17

KDE/as

**BEST AVAILABLE COPY**

Serial No.: 10/713,773

Amendment dated 01 November 2005

Reply to Office Action mailed 01 September 2005

wherein a carrier portion of the label assembly remains on the apparatus following application of the label portion onto the object. Because the references, individually or in combination, do not teach or suggest all claim limitations, Applicants request withdrawal of the obviousness rejection.

### Conclusion

Applicant believes that the above Amendment and remarks address each and every issue raised by the Examiner, overcome each and every objection and rejection, and place all Claims in condition for allowance. However, should the Examiner detect any remaining issue, Applicant kindly requests the Examiner to contact the undersigned, preferably by telephone, in an effort to expedite examination of this U.S. Patent Application.

Respectfully submitted,



Kevin D. Erickson  
Registration No. 38,736

Pauley Petersen & Erickson  
2800 West Higgins Road  
Suite 365  
Hoffman Estates, Illinois 60195  
TEL (847) 490-1400  
FAX (847) 490-1403

CD-134

18

**BEST AVAILABLE COPY**  
KDE/as